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STEVEN L. NICHOLS RADER, FISHMAN & GRAVER PLLC 10653 S. RIVER FRONT PARKWAY SUITE 150 SOUTH JORDAN, UT 84095			EXAMINER LAMBRECHT, CHRISTOPHER M	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/826,198  
Filing Date: April 04, 2001  
Appellant(s): BESSEL, DAVID H.

**MAILED**  
**MAY 17 2007**  
**Technology Center 2600**

\_\_\_\_\_  
Steven L. Nichols  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 22, 2006 appealing from the Office action mailed October 5, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 6,483,986 B1	Krapf	Nov. 19, 2002 (filed May 26, 2000)
US 6,788,882 B1	Greer et al. (Greer)	Sep. 7, 2004 (filed Apr. 17, 1998)
US 2004/0261112 A1	Hicks, III et al. (Hicks)	Dec. 23, 2004 (filed Dec. 28, 2004)

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

- a. Claims 1, 5-8, 10, 12, 13, 15, 16, 18-20, and 22-27 stand rejected under 35 U.S.C. 102(e) as being anticipated by Hicks.

Regarding claim 1, Hicks discloses a television signal processing and recording system for handling both digital and analog video signals, said system comprising: a video decoder (A/D 125, fig. 2) in an analog signal path for converting an analog signal to a digital signal (¶0047, ll. 18-24); an encoder (A/D 125, fig. 2) for compressing said digital signal output by said video decoder (¶0047, ll. 18-24, converting to MPEG-2 format inherently comprises compression); and a connection (295, fig. 2, or 95, figs. 1 & 3) for routing said compressed digital signal into a digital signal path in which said

compressed digital signal is selectively either decompressed with a decoder (325, fig. 3, of set-top box 300) and output to a television set (40, fig. 3, ¶0054, ll. 3-10 and ¶0050, ll. 14-18) or recorded on a digital data storage device (103, fig. 2, ¶0046, ll. 5-12).

As to claim 5, Hicks discloses the system of claim 1, wherein said digital data storage device is a hard disk drive (¶0040).

As to claim 6, Hicks discloses the system of claim 1, further comprising an analog tuner for outputting said analog signal to said video decoder (¶0039, where a tuner that receives an analog signal is inherently an analog tuner).

As to claim 7, Hicks discloses the system of claim 1, wherein said encoder is an MPEG2 encoder (¶0039).

As to claim 8, Hicks discloses the system of claim 1, wherein said decoder is an MPEG2 decoder (where the signal has been compressed according to MPEG2 format, ¶0039, the associated decoder, ¶0055) is inherently an MPEG2 decoder).

As to claim 10, Hicks discloses the system of claim 1, wherein said digital data storage device is incorporated in a personal video recorder (where element 100 of fig. 1/110 of fig. 2 comprises a personal video recorder).

Regarding claim 12, Hicks discloses a method of processing and recording a television signal that handles both digital and analog video signals, said method comprising: converting an analog signal to a digital signal (¶0039); and compressing (where converting the signal to MPEG format, ¶0039, inherently comprises compression)

and decompressing (§0055, ll. 14-18) said digital signal before outputting said digital signal to a television set (40, fig. 3, §0054, ll. 3-10).

As to claim 13, Hicks discloses the method of claim 12, further comprising, after converting said analog signal to said digital signal and after compressing said digital signal, routing said compressed digital signal from an analog signal path to a digital signal path in which said compressed digital signal is decompressed (325, fig. 3, of set-top box 300) and output to a television set (40, fig. 3, §0054, ll. 3-10 and §0050, ll. 14-18).

As to claim 15, Hicks discloses the method of claim 13, further comprising tuning a digital signal with a digital tuner and outputting said tuned digital signal into said digital path (§0041).

As to claim 16, Hicks discloses the method of claim 12, further comprising, after converting said analog signal to said digital signal and after compressing said digital signal (§0039), recording said compressed digital signal on a digital data recording device (§0040).

Regarding claim 18, Hicks discloses a system for processing and recording a television signal that handles both digital and analog video signals, said system comprising: means for converting an analog signal to a digital signal (§0039); means for compressing and decompressing said digital signal (§0039, where converting said signal to MPEG format inherently comprises compression).

As to claim 19, Hicks discloses the system of claim 18, further comprising means for outputting said digital signal to a television set (§0042, ll. 1-14, §0054, ll. 3-10).

As to claim 20, Hicks discloses the system of claim 18, further comprising means for recording said digital signal when said digital signal is compressed (§0039, §0046).

Regarding claim 22, Hicks discloses a television signal processing and recording system for handling both digital and analog video signals, said system comprising: a video decoder (125, fig. 2) in an analog signal path for converting an analog signal to a digital signal (§0047, ll. 18-24); an encoder for compressing said digital signal output by said video decoder (where converting a signal to MPEG, §0047, ll. 18-24, inherently comprises compression); and a decoder (325, fig. 3, of set-top box 300) for decompressing said digital signal compressed by said encoder (§0055, ll. 14-18).

As to claim 23, Hicks discloses the system of claim 22, further comprising a connection for outputting said digital signal to a television set (40, fig. 3) when said digital signal is decompressed (§0054, ll. 3-10).

As to claim 24, Hicks discloses the system of claim 22, further comprising a digital data storage device (103, figs. 1 & 2) for recording said digital signal when compressed by said encoder (§0046, ll. 5-12).

As to claim 25, Hicks discloses the system of claim 22, further comprising a digital tuner (§0041) for outputting a tuned digital signal to (via 95 of figs. 1 & 3) said decoder (325, fig. 3).

As to claim 26, Hicks discloses the system of claim 22, further comprising an analog tuner for outputting a tuned analog signal to said video decoder (¶0039, where a tuner that receives an analog signal is inherently an analog tuner).

As to claim 27, Hicks discloses the system of claim 22, wherein said digital data storage device is a hard disk drive (¶0040).

- b. Claims 2-4 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks.

Regarding claim 2, Hicks discloses the system of claim 1, but fails to disclose a demultiplexer for demultiplexing said compressed digital signal when said compressed digital signal is routed to said data path. Examiner takes Official notice of the fact that it is well known in the art to provide a demultiplexer for demultiplexing an MPEG encoded television signal prior to decoding said signal for display, for the purpose of routing MPEG video data to video decoding hardware and MPEG audio to audio decoding hardware, such that the MPEG stream may be more efficiently decoded. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hicks to include a demultiplexer in said digital signal path for receiving and demultiplexing said compressed digital signal when said compressed digital signal is routed to said data path or a digital signal received in digital format and not sent through said video decoder, for the purpose of enabling efficient A/V decompression.

As to claim 3, Hicks discloses the system of claim 2 as set forth above, further comprising a digital tuner for outputting a tuned digital signal into said digital signal path (¶0041).

As to claim 4, Hicks discloses the system of claim 3, as set forth above, but fails to disclose said digital tuner outputs said digital signal to said multiplexer. Examiner takes Official notice of the fact that it is well known in the art for digital broadcasts (received by said digital tuner) to employ MPEG compression, and that it is well known in the art to provide a demultiplexer for demultiplexing an MPEG encoded television signal prior to decoding said signal for display, for the purpose of routing MPEG video data to video decoding hardware and MPEG audio to audio decoding hardware, such that the MPEG stream may be more efficiently decoded. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hicks such that said digital tuner outputs said digital signal to said multiplexer, for the purpose of enabling efficient A/V decompression.

Regarding claim 14, Hicks discloses the method of claim 13, wherein said compressed digital signal (MPEG encoded) is routed to said digital signal path, but fails to disclose demultiplexing said compressed digital signal. Examiner takes Official notice of the fact that it is well known in the art to demultiplex an MPEG encoded television signal, for the purpose of routing MPEG video data to video decoding hardware and MPEG audio to audio decoding hardware, such that the MPEG stream may be more efficiently decoded. Therefore, it would have been obvious to one of ordinary skill in the

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art at the time the invention was made to modify the system of Hicks to demultiplex said compressed digital signal when said compressed digital signal is routed to said data path, for the purpose of enabling efficient A/V decompression.

c. Claims 9 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks in view of Krapf.

Regarding claim 9, Hicks discloses the system of claim 1, wherein said video encoder (125, fig. 2), encoder (125, fig. 2), and connection (coupling of signal path from A/D 125 and signal line 145, fig. 2) are incorporated in a personal video recorder (where element 100 of fig. 1/110 of fig. 2 comprises a personal video recorder) and said decoder (325, fig. 3) is incorporated in a set-top box (300, ¶0055), but fails to disclose said video decoder, encoder and connection are incorporated in a set-top box. Krapf discloses integrating the components of a personal video recorder (2, fig. 1) and a set-top box (24, fig. 1) as a single unit (col. 6, ll. 28-32), for the purpose of enabling the recorder to internally tune to a selected one of a plurality of channels (col. 6, ll. 31-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hicks such that said video decoder, encoder and connection are incorporated in a set-top box, as taught by Krapf, for the purpose of enabling the recorder to internally tune to a selected one of a plurality of channels.

Regarding claim 11, Hicks discloses the system of claim 1, wherein said video decoder (125, fig. 2), encoder (125, fig. 2), connection (coupling of signal path from A/D

125 and signal line 145, fig. 2) and digital data storage device (103, fig. 2) are incorporated in a personal video recorder (where element 100 of fig. 1/110 of fig. 2 comprises a personal video recorder) and said decoder is incorporated in a set-top box (300, ¶0055), but fails to disclose said video decoder, encoder, connection and digital data storage device are incorporated in a single set-top unit. Krapf discloses integrating the components of a personal video recorder (2, fig. 1) and a set-top box (24, fig. 1) as a single unit (col. 6, ll. 28-32), for the purpose of enabling the recorder to internally tune to a selected one of a plurality of channels (col. 6, ll. 31-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hicks such that said video decoder, encoder, connection and digital data storage device are incorporated in a set-top box, as taught by Krapf, for the purpose of enabling the recorder to internally tune to a selected one of a plurality of channels.

d. Claims 17 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks in view of Greer.

Hicks discloses the method of claims 16 and 20, wherein said recording is performed by a personal video recorder (where element 100 of fig. 1/110 of fig. 2 comprises a personal video recorder), but fails to disclose converting and compressing said digital signal are performed with a set-top box. In an analogous art, Greer discloses converting and compressing said digital signal are performed with a set-top box (e.g. 250a, fig. 2, col. 7, ll. 26-29, where set-top boxes correspond to set-top box cards,

performing A/D conversion and compression, col. 7, ll. 9-15), enabling an external set-top box to be coupled to a recorder for digital video recording (col. 7, ll. 30-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hicks to include converting and compressing said digital signal are performed with a set-top box, as taught by Greer, for the purpose of enabling an external set-top box to be coupled to a recorder for digital video recording.

#### **(10) Response to Argument**

##### Claims 1-27 Rejected Based on Hicks:

Hicks was first applied as prior art against claims 1-27 of this application in the non-final Office action (mailed Mar. 10, 2005). Appellant filed a response on June 15, 2005 including a declaration by Appellant's attorney under 37 C.F.R. § 1.132, an unsigned declaration by Appellant under 37 C.F.R. § 1.131, and a document dated September 22, 2000 ("Disclosure Document"). A signed copy of Appellant's rule 1.131 declaration was later submitted in a supplemental response filed July 20, 2005.

These declarations were found to be ineffective to overcome the rejections based on the Hicks reference, and the final Office action (mailed Oct. 5, 2005) continued the rejections of claims 1-27. After filing a notice of appeal on November 23, 2005, Appellant submitted a response under 37 C.F.R. § 1.116 on January 19, 2006, which included a new declaration under rule 1.131. Because the response was neither

seasonably presented nor sufficient to overcome the rejections of the appealed claims, it was denied entry.<sup>1</sup>

Thus, the following evidence is of record in this application: the unsigned declaration by Appellant under rule 1.131 (filed Jun. 15, 2005), the declaration by Appellant's attorney under rule 1.132 (filed Jun. 15, 2005), the Disclosure Document (filed Jun. 15, 2005), and the signed declaration by Appellant under rule 1.131 (filed July 20, 2005). This evidence is insufficient to antedate the Hicks reference.

Actual Reduction to Practice:

Appellant argues that the Disclosure Document "represents an actual reduction to practice of the invention claimed in this application" because "one of skill in the art could have, with the document, been enabled to make and use the invention without undue experimentation." (Br. 7.) Even if this were true, however, "proof of an actual reduction to practice requires a showing that the apparatus actually existed . . . ." MPEP 715.07(III). Appellant has provided no evidence that the subject matter of claims 1-27 actually existed. Although "there are some devices so simple" that photographs showing "a mere construction of them" is sufficient, see *id.*, Appellant has shown no such construction.

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<sup>1</sup> The Examiner notes that although a notice of appeal had been filed, this was not indicated in the advisory action.

Thus, the evidence of record fails to establish that Appellant had conducted an actual reduction to practice of the claimed subject matter prior to the filing date of the Hicks reference.

Constructive Reduction to Practice:

Alternatively, Appellant argues that the Disclosure Document is evidence of conception of the claimed invention prior to the filing date of Hicks, and “Appellant worked diligently toward the filing of the instant application, i.e., the constructive reduction to practice.” (Br. 9.) However, the declaration filed on 20 July 2005 under 37 CFR 1.131 is ineffective to overcome the Hicks reference. The declaration is deficient because it lacks an allegation that the invention was conceived and/or reduced to practice in the US, a NAFTA country, and/or WTO country, as required by 37 CFR 1.131(a). Thus, while the Disclosure Document might be relied upon to show conception of the claimed invention prior to the effective date of the Hicks reference, facts necessary to establish prior conception under rule 1.131 are lacking. In addition, The declaration is deficient because the declaration itself contains only conclusory statements as to when the invention was conceived by the inventor. The body of the declaration contains no facts or evidence supporting these statements, i.e., no proof of conception, as required by 37 CFR 1.131(b). Accordingly, this declaration under 37 CFR §1.131 is insufficient.


Appellant has not submitted an appropriate affidavit or declaration alleging facts sufficient to establish diligence. The only allegations of diligence include statements

made by Appellant's attorney in the appeal brief and the pre-appeal brief (filed Feb. 21, 2006); the pre-appeal brief includes only an informal declaration by Appellant's attorney under 37 C.F.R. § 1.132 (pre-appeal br. at 4).

Thus, the evidence of record fails to show conception coupled with diligence from prior to the filing date of the Hicks reference until a subsequent constructive reduction to practice that occurred upon the filing of this application.

**(11) Related Proceeding(s) Appendix**


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

  
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SUPERVISORY PATENT EXAMINER  
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Chris Lambrecht

  
**ANDREW Y. KOENIG**  
**PRIMARY PATENT EXAMINER**  
*Acting SPE - AU 2623*

Conferees: